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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

GARY P. MORRISON ET AL.

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For: CHIP-SCALE PACKAGES STACKED ON FOLDED INTERCONNECTOR FOR VERTICAL ASSEMBLY ON SUBSTRATES

Art Unit 2827

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REPLY BRIEF

In reply to the Examiner's Answer, it is noted that the issue in this case is very simple and very clear. The issue is based solely on the definition of "invention" under 35 U.S.C. 102. This is precisely the issue in Pfaff v Wells, 525 U.S. 55, 119 S. Ct. 304, 142 L. Ed. 261, 48 USPQ2d 1641 (hereinafter "Pfaff")..

It is elementary that the examiner has no authority to overrule the U.S. Supreme Court. It is also clear that the above-noted Pfaff decision specifically relates to the definition of "invention" as it is applied under 35 U.S.C. 102. The fact that the above noted Pfaff decision also involves the issue of an on-sale bar is totally irrelevant to the issue in this case. In order to arrive at its decision whether on not there was an on-sale bar, the Court first had

to define the term "invention" as it applied to section 102 of 35 U.S.C. This the Court did. This definition of "invention" applies to 35 U.S.C. 102 in all cases and not only to on-sale bars as the examiner appears to state. The U.S. Supreme Court never limited its definition of invention under 35 U.S.C. 102 solely to on-sale bar situations The examiner's position is therefore without merit and contrary to the law or logic. It follows that the discussion at page 9ff of the Examiner's Answer under "A" is irrelevant to the issue herein and is nothing more than a smokescreen.

With reference to "B" of the Examiner's Answer (page 10), again the reference to on-sale bar is irrelevant to the issue herein. Furthermore, the "Disclosure Form" submitted to the Texas Instruments Patent Department and submitted with the amendment filed July 9, 2004 contains both drawings and text describing the invention in a manner ready for patenting in accordance with the dictates of the U.S. Supreme Court in the Pfaff decision. In add ition, there is no issue as to whether or not the "Disclosure Form" provides sufficient detail to construct the invention since this issue was never challenged by the examiner during prosecution. It cannot be challenged at this point in the prosecution of this application. However, even if it were challenged, it is clear to one skilled in the art what has been invented and how to construct the invention from a reading of the "Invention Disclosure".

With regard to the question of diligence, it is clear from the record that appellants were diligent ab initio. At no time was there a material hiatus. The only problem was that the subject application was, according to the Patent and Trademark Office, erroneously filed more than on year after filing of the provisional application. In fact, it is the belief of the attorney who originally filed the subject application that the subject application was filed

within the one year after filing of the provisional application and did not receive a proper filing date due to failure to establish mailing due to loss of the Express Mail Receipt. It would appear logical that in order for the subject application to have a filing date of January 3, 2002, it must have been placed in the mail prior to that date. It follows from these facts that the hiatus from the abandonment of the provisional application and the filing of the subject application was only a few days. In addition diligence cannot be an issue in this case, even were it to be an available issue, which it is not in view of Pfaff.

The position taken in "D" of the Examiner's Answer on page 11ff is also without merit. The C.F.R. cannot override 35 U.S.C. of the U.S. Supreme Court. To the extent that 37 C.F.R. 1.131 is in conflict with the Pfaff decision, the Pfaff decision is controlling. For that reason alone the arguments in this paragraph are without merit. Furthermore, conception with diligence has been demonstrated as noted above and in the Brief on Appeal.

With reference to section II on page 14 of the Examiner's Answer, the arguments presented above clearly refute the allegations in this section.

With reference to section III on page 15 of the Examiner's Answer, it is clear that the provisional application is evidence of conception, if not more, and this is established at least by the decision cited in the Examiner's Answer, namely In re Costello. Since the provisional application is admittedly a basis to establish conception (it also establishes that the invention was "ready for patenting"), it is ludicrous to state that there is no diligence when the hiatus from the abandonment of the provisional application to the filing of the subject application is a matter of a few days.

It is abundantly clear that the invention disclosed in the subject application was "ready for patenting" prior to the effective date of the Inaba patent under the dictates of the Pfaff decision. The Pfaff decision overrides the C.F.R., the M.P.E.P and defines the meaning of "invention" under 35 U.S.C. 102.

In view of the above and the arguments presented in the Brief on Appeal. Inaba (JP-2001-217388) is not available as a reference under 35 U.S.C. 102(e) in view of the definition of "invention" under 35 U.S.C 102 by the U.S. Supreme Court and, accordingly, the rejection is without merit. Accordingly, the final rejection should be reversed and the rejected claims allowed that justice be done in the premises.

Respectfully submitted,

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